



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/118,668	07/17/98	PETERSON	B 14689.1

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EXAMINER

RIMELL, S

ART UNIT

PAPER NUMBER

2166

DATE MAILED:

01/31/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/118,668

Applicant(s)

PETERSON ET AL.

Examiner

Sam Rimell

Art Unit

2166

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

SAM RIMELL
PRIMARY EXAMINER
AU 2/66

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 8-11 and 21-29 are rejected under 35 U.S.C. 101 because the invention as claimed is inoperative and therefore lacks utility.

Claim 8, lines 13-17 calls for the method step of determining an adjudication status of a claim and how much the health care provider is to be paid. However, this step requires that this determination be made "before the claim is submitted for processing". Strictly speaking, it is impossible to make any kind of determination on a health care claim "before the claim is submitted for processing", since no data is available to the processing system at that point, and no other submission of data will have occurred at that point. Some preliminary data must be submitted to the processing system in order to allow the processing system to make a decision. This appears to be what is actually occurring in applicant's invention, so claim 8 should be amended to address this preliminary submission of data, otherwise, claim 8 will describe a process that cannot possibly be performed.

Independent claims 21 and 29 contain the same defect, requiring determinations to be made before the claim or any other preliminary data is submitted.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7 and 12-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Claimsnet.com website.

The Claimsnet.com website is reproduced by the examiner as a 25 page document, with each of the 25 pages numbered, beginning with "Overview" on page 1 and ending with the "Audit Reports" on page 25.

The date of this reference is established by the article entitled "Claimsnet flies IPO to fund Internet Service" which states that Claimsnet has been offering its services since 1996. Accordingly, the Claimsnet.com website constitutes prior art under 35 USC 102(b).

The Claimsnet.com is a processing system that includes a component for storing patient and benefit information (page 9, requiring doctor fill in fields of electronic HCFA form); an automated adjudication component (page 14, auto adjudication of claim from HCFA 1500 form); an automated payment component (page 12, linkage to payors); and a payment tracking component (page 21, illustrating processing status of claim).

In the Claimsnet.com process, a healthcare provider accesses a blank template (such as a blank HCFA 1500 form) in order to ascertain the patient information and treatment information needed in order to submit a claim (described on page 9). A claim is provided by entering the information into the template (described on page 9).

Using an "interactive mode" (page 22), the claim may be pretested to determine if the claim can be automatically adjudicated by the processing system. If the claim does not pass the test, the claim is returned to the health care provider for manual adjustment of the submitted information. (pages 2 and 22). This manual adjustment may be viewed as manual adjudication, since it entails a manual analysis of the claim by the health care provider that ultimately leads to payment of the claim.

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If the claim is resubmitted and it passes the requirements, the claim is automatically adjudicated by the processing system, by matching the claim to pre-programmed payors (insurance companies) who ultimately pay the claim.

Once the claim has been matched to a pre-programmed payor, the claim is then sent electronically to the payor for automatic payment of the claim.

The processing status of the claims may be continuously tracked (page 21).

The payment of the actual claim is intended to be made electronically (see "electronic remittance advice" on page 1).

Printed invoices may also be produced (pages 18-20, and 24-25).

The entire process is conducted by a website on the Internet.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.



Sam Rimell
Primary Examiner
Art Unit 2166